



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,506	01/16/2001	Timothy K. Doherty	BGE-1	5918
27104	7590	03/27/2006	EXAMINER	
DAHL & OSTERLOTH, L.L.P. 555 SEVENTEENTH STREET SUITE 3405 DENVER, CO 80202-3937			ROSEN, NICHOLAS D	
		ART UNIT	PAPER NUMBER	
		3625		

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/761,506	DOHERTY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 January 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

Claims 1-37 have been examined.

### ***Claim Objections***

Claim 36 is objected to because of the following informalities: In the second-last line of claim 36 (the twenty-eighth line), "after the identifier means" is ungrammatical, apparently a phrase copied from another claim with means rather than steps. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the thirty-third and thirty-fourth lines of claim 1 (the last two lines of the claim), "the set of advertisements stored separate from another" is not described in the specification, if the limitation be read as stating that each advertisement is stored separately from the other advertisements. (The

Art Unit: 3625

advertisements are described as being stored separately from the multimedia presentation.)

Claims 32-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the twenty-fifth and twenty-sixth lines of claim 32 (the last two lines of the claim), "the set of advertisements stored separate from another" is not described in the specification, if the limitation be read as stating that each advertisement is stored separately from the other advertisements. (The advertisements are described as being stored separately from the multimedia presentation.)

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the thirty-third and thirty-fourth lines of claim 35, "the set of advertisements stored separate from another" is not described in the specification, if the limitation be read as stating that each advertisement is stored separately from the other advertisements. (The advertisements are described as being stored separately from the multimedia presentation.)

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the thirty-seventh line of claim 37, “the set of advertisements stored separate from another” is not described in the specification, if the limitation be read as stating that each advertisement is stored separately from the other advertisements. (The advertisements are described as being stored separately from the multimedia presentation.)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites, “the set of advertisements stored separate from each other,” in the thirty-third and thirty-fourth lines of the claim (the last two lines). This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claims 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3625

applicant regards as the invention. Claim 32 recites, "the set of advertisements stored separate from each other," in the twenty-fifth and twenty-sixth lines of the claim (the last two lines). This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 recites, "the set of advertisements stored separate from each other," in the thirty-third and thirty-fourth lines of the claim. This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 recites, "the set of advertisements stored separate from each other," in the thirty-seventh line of the claim. This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-31**

Claims 1, 2, 4, 8, 9, 10, 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206) and Markus et al. (U.S. Patent 6,490,601). As per claim 1, Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item

within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifier means for identifying at least one demographic characteristic of a user, wherein the at least one demographic characteristic of the user corresponds to one of the at least one demographic indicator (inherent from column 2, lines 36-52); selector means for selecting a relevant advertisement from the set of advertisements, the selector means configured to receive the at least one demographic characteristic of the user from the identifier means, and the selector means including a comparison of the user's at least one demographic characteristic with the at least one demographic characteristic of each advertisement to select the relevant advertisement for the user (inherent from column 2, line 26, through column 3, line 5, and column 8, lines 3-10; providing an appropriate animation sequence or other Web page component based on the geographic location of a visitor is held to imply means for making necessary comparisons, etc.); inserter means for inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, the inserter means configured to receive the relevant advertisement from the selector means so as to create an advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics, and configured to insert the relevant advertisement after identifying the at least one demographic characteristic (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery

means for delivering the multimedia presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66, through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

As per claim 2, Gever discloses a hyperlink in the advertisement or other multimedia presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6).

As per claim 4, Gever discloses that the multimedia presentation is an animation (Abstract; and repeated references to animation throughout the Gever patent).

As per claim 8, neither Gever nor Singh expressly discloses that the multimedia presentation includes at least two embedded placeholders, but Gever discloses creating one or more individualized Web page components (column 2, lines 9-11), and it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)).

Furthermore, Markus teaches that many Web pages contain links to dozens of separate remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the multimedia presentation include at least two embedded placeholders, for the obvious advantage of presenting several advertisements, other Web page components, or parts thereof.

As per claim 9, Gever discloses multiple advertisements (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10). Neither Gever nor Singh expressly discloses that there are multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, but it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for

multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)).

Furthermore, Markus teaches that many Web pages contain links to dozens of separate remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for there to be multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, for the obvious advantage of presenting multiple ads, at different points in a web site, and/or at different times during a multimedia presentation.

As per claim 10, Gever discloses that the identifier means can include cookies generated by an Internet browser of the user (column 15, line 60, through column 16, line 8, the browser being held to follow from the cookies and other Internet-related procedure, as in column 1, lines 11-21).

As per claim 11, Gever discloses that the identifier means can include a survey completed by the user (column 15, line 49, through column 16, line 8).

As per claim 12, Gever does not expressly disclose that the inserter means is a computer program, but does disclose that the inserter means involves manipulating Web pages (column 2, line 14 through column 3, line 5; and column 8, lines 3-10), and discloses prior art programs for preparing Web pages (column 1). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the inserter means to be (or comprise) a computer program, for the obvious advantage of inserting relevant advertisements automatically according to

demographics and other factors, without having to employ a human being to monitor Web traffic and make insertions by hand.

As per claim 15, Gever discloses that the components of a Web page (which, as above, may be multimedia presentations, or parts of a multimedia presentation) may not be situated on a server, but only referenced by URL address (which implies being stored on a second server elsewhere) (column 15, lines 3-16).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 2 above, and further in view of LeMole et al. (U.S. Patent 6,009,410). Gever does not expressly disclose that the hyperlink in the advertisement is a hyperlink to an advertiser's website (although "LINK1 = 'WWW.BUYLATER.COM'" in Figure 4 is highly suggestive). However, it is well known for advertisements to contain hyperlinks to an advertiser's website, as taught, for example, by LeMole (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the hyperlink in the advertisement to be a hyperlink to an advertiser's website, for the obvious advantage of encouraging users to browse catalogs, etc., and make purchases at the advertiser's website.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 4 above, and further in view of the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0." As per claim 5, Gever does not disclose that the animation is created using Flash, but Flash is a well-known system for creating animations, as taught by "Macromedia Flash

Animation Now Native in RealSystem 5.0" (note that the paragraph beginning "Advertisers using Flash" specifically teaching using Flash to create advertisements for the Web, complete with animation). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the animation to be created using Flash, for the obvious advantage of readily creating animations viewable by many client systems.

As per claim 7, Gever discloses selecting from a plurality of pre-existing animation sequences (column 2, lines 9-20), an embedded placeholder presumably being added, as per Singh, to enable the desired pre-existing or modified animations to be displayed as desired.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, and the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," as applied to claim 5 above, and optionally further in view of Borella et al. (U.S. Patent 6,182,125). Gever does not expressly disclose that the animation is an original presentation, but it could be taken as inherent that some animations are original presentations (not all animations could be copies of each other). Furthermore, the article, "Macromedia Flash Animation Now Native in RealSystem 5.0," discloses creating animations. But if, arguendo, this does not suffice, Borella teaches web pages including original content, including animation (column 4, lines 41-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the Flash animation to be an original presentation, for the obvious advantage of enabling the presenter to provide an animation according to his

own desires and tastes, and to avoid having to pay royalties to someone else for use of a copied presentation.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 12 above, and further in view of Simpson (U.S. Patent 6,453,300). Gever does not expressly disclose that the computer program is Generator, but Macromedia Generator is well known, as taught by the Simpson patent, which specifically teaches using Macromedia Generator in conjunction with Flash to personalize presentations (column 12, lines 3-16). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use Generator, for the obvious advantage of accomplishing the creation of Flash or similar animations using a standard, widely available package for that purpose.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 12 above, and further in view of Chen et al. (U.S. Patent 5,822,524). Gever does not expressly disclose that the computer program and the multimedia presentation are stored on the same server, but it is well known for various programs, data files, etc., to be stored on the same server, as taught, for example, by Chen (column 1, lines 21-64). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer program and the multimedia presentation both stored on the first server, for the obvious advantage of ready accessibility.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 1 above, and further in view of the Microsoft

Press Computer Dictionary and Jones ("Working on Site"). As per claim 16, Gever discloses delivery over a connection between a server storing the Web page component (which can be a multimedia presentation, as above) and discloses a viewer/user to whom pictures are transmitted, implying a computer operated by the user (column 9, lines 46-55). Gever does not expressly disclose that the connection is an Internet connection, but does refer to network connections and a Web page component. The Internet is a well-known network, as taught, for example, by the Microsoft Press Computer Dictionary (second definition of "Internet" on page 258, and subsequent entries relating to the Internet on pages 259-261) and it is well known that the World Wide Web is part of the Internet, as taught, for example, by Jones (Abstract, and paragraph beginning, "Marketers should be familiar"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the network connection to be an Internet connection, for the obvious advantage of connecting to the enormous number of people who access the Internet.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, the Microsoft Press Computer Dictionary and Jones ("Working on Site") as applied to claim 16 above, and further in view of official notice. Gever does not disclose a syndication network, but official notice is taken that syndication networks (as defined by the instant specification, page 10, lines 19-21) are well known, e.g., advertisers who supply banner ads to one or more Websites for publication. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention for the system to comprise a syndication network, for the obvious advantage of readily placing advertisements or other desired components on multiple Web sites.

Claims 18, 19, 21, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, the Microsoft Press Computer Dictionary, Jones ("Working on Site"), and official notice as applied to claim 17 above, and further in view of Kauffman et al. (U.S. Patent Application Publication 2002/0073084). As per claim 18, Kauffman teaches a syndication network collecting a multimedia presentation and a selected advertisement, and delivering the multimedia presentation containing the selected advertisement to the user's computer (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 19, Kauffman teaches that the syndication network collects the multimedia presentation and the selected advertisement separate from one another, and a server in the syndication network inserts the selected advertisement into the multimedia presentation (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 20, Neither Gever nor Kauffman discloses a syndication network that collects the multimedia presentation having the selected advertisement inserted therein previous to entering the syndication network, but official notice is taken that it is well known to collect presentations or programs having advertisements already inserted therein (an example would be TV stations receiving and broadcasting national programs with nationwide advertisements already inserted by the networks). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network collect the multimedia presentation having the selected advertisement inserted therein previous to entering the syndication network, for the obvious advantage of distributing presentations with ads already included, the ads being either likely to be of interest to many viewers in general, or likely to be of interest to many viewers of the multimedia presentation.

As per claim 21, Kauffman teaches that the syndication network collects information relating to the identifier means from the user's computer (or other device), and delivers the identifier information to a rule server (selection means) which selects appropriate advertisements (see especially paragraph 19; also Figure 1). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 24, Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but official notice is taken that media buyers brokering advertising space, etc., are well known. Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), as in claim 21, and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places.

As per claim 25, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer and from the media buyer to the selector means, but official notice is taken that it is well known to forward information from one party to another. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver the identifier information from the syndication network to the media buyer and from the media buyer to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

As per claim 26, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but official notice is taken that it is well known to deliver information to multiple concerned parties (for example, CC'ing emails). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier

information is delivered from the syndication network to the media buyer and also to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 1 above, and further in view of McCarthy et al. (U.S. Patent 6,904,408). Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but media buyers brokering advertising space, etc., are well known, as taught, for example, by McCarthy (column 16, lines 15-24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, and McCarthy as applied to claim 22 above, and further in view of official notice. Gever does not disclose that the media buyer receives information relating to the identifier means from the user's computer, but official notice is taken that it is well known for advertisers to receive information relating to identifier means from a user's computer. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the media buyer to receive information relating to identifier means from a user's computer, for such obvious advantages as determining what advertisements to present to a user (based on

demographics, etc.), billing for presentation of relevant advertisements to users in relevant categories, and enabling the advertiser/media buyer to contact the user if the user expresses interest, orders goods or services, etc.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 1 above, and further in view of Krishan et al. (U.S. Patent 6,442,529). As per claim 27, Gever does not disclose means for assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, but it is well known to charge the sponsors of advertisements for running or displaying their ads, as taught, for example, by Krishan (column 1, lines 46-54). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, for the stated advantage of making money from displaying the selected advertisement.

Claims 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, and Krishan as applied to claim 27 above, and further in view of official notice. As per claim 28, Gever does not disclose that the sponsor's advertising charge is paid to an owner of the multimedia presentation, but official notice is taken that it is well known for advertising charges to be paid to the owners of programs in which the ads appear. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertising charge to be paid to an owner of the multimedia

presentation, for the obvious advantage of making money for displaying ads in multimedia presentations, or, from another perspective, for the obvious advantage of persuading the owners of multimedia presentations to display one's ads.

As per claim 29, Gever does not disclose that the sponsor's advertisement charge is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement, but official notice is taken that it is well known to make payments (commissions) to media buyers; for payments to owners of multimedia presentations, see rejection of claim 28 above. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertisement charge to be apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement, for the reasons set forth above in rejecting claim 28, and for the obvious advantage of compensating a media buyer for its services in placing ads.

As per claim 30, Gever does not disclose that the sponsor's advertisement charge is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the selected advertisement, and an owner of the delivery means for providing the multimedia presentation to the user, but official notice is taken that it is well known to make payments to owners of delivery means (websites, ISP's, cable TV companies, etc.); for payments to owners of multimedia presentations and media buyers, see rejection of claims 28 and 29 above. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the sponsor's advertisement charge to be apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the selected advertisement, and an owner of the delivery means for providing the multimedia presentation to the user, for the reasons set forth above in rejecting claims 28 and 29, and for the obvious advantage of compensating the owner of delivery means for his services in allowing an ad to run, or from the other perspective, of profiting from running ads.

As per claim 31, Gever does not disclose that the delivery means is a syndication network, but official notice is taken that syndication networks (as defined by the instant specification, page 10, lines 19-21) are well known, e.g., advertisers who supply banner ads to one or more Websites for publication. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the delivery means to be a syndication network, for the obvious advantage of placing advertisements or other desired components on multiple Web sites.

It is noted that claims 1-31 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**Claims 32-34**

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206) and Markus et al. (U.S. Patent 6,490,601). Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifier means for identifying a user (inherent from column 2, lines 36-59); selector means for selecting a relevant advertisement from the set of advertisements, wherein the selector means select the relevant advertisement subsequent to the identification of the user by the identifier means (column 2, line 26, through column 3, line 5, and column 8, lines 3-10); inserter means for inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, the inserter means configured to receive the relevant advertisement from the selector means so as to create a seamless advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics, and configured to insert the relevant advertisement after identifying the at least one demographic characteristic (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery means for delivering the multimedia

presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66, through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 32 above, and further in view of Sawyer (U.S.

Patent 6,084,628). Gever does not disclose that the selector randomly selects the advertisement, but Sawyer teaches randomly selecting advertisements (column 4, lines 57-65). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the selector to randomly select the advertisement, for the stated advantage of ensuring that each advertisement reflected in a profile is shown an appropriate number of times.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 32 above, and further in view of Kauffman et al. (U.S. Patent Application Publication 2002/0073084). Gever does not expressly disclose that the seamless advertisement is dynamically contained in the multimedia presentation, but Kauffman teaches this (paragraphs 17-20). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for seamless advertisement to be dynamically contained in the multimedia presentation, for the obvious advantage of presenting dynamic advertisements to viewers.

It is noted that claims 32-34 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be

construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**Claim 35**

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S. Patent Application Publication 2002/0073084), Markus et al. (U.S. Patent 6,490,601), the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent 6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent 6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa," and optionally in view of Borella et al. (U.S. Patent 6,182,125). Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); cookies generated by an Internet browser of a user for identifying at least one demographic characteristic of the user (column 15, line 60, through column 16, line 8, the browser

being held to follow from the cookies and other Internet-related procedure, as in column 1, lines 11-21); selector means for selecting a relevant advertisement from the set of advertisements, the selector means configured to receive at least one demographic characteristic of the user (column 2, line 26, through column 3, line 5, and column 8, lines 3-10). Gever does not expressly disclose the selector means comparing the user's cookies with the demographic indicators of advertisements, but given the disclosure of cookies, and of selecting advertisements or other Web page components based on demographic characteristics, this is obvious. Gever discloses inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, creating an advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics, after identifying at least one demographic characteristic of the user (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting

whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that the multimedia presentation is a Flash animation multimedia presentation, but Flash is a well-known system for creating animations, as taught by "Macromedia Flash Animation Now Native in RealSystem 5.0" (note that the paragraph beginning "Advertisers using Flash" specifically teaching using Flash to create advertisements for the Web, complete with animation). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the animation to be created using Flash, for the obvious advantage of readily creating animations viewable by many client systems.

Gever does not disclose a Macromedia Generator computer program for inserting the relevant advertisement into the embedded placeholder, but Macromedia Generator is well known, as taught by the Simpson patent, which specifically teaches using Macromedia Generator in conjunction with Flash to personalize presentations by inserting particular data (column 12, lines 3-16). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use Macromedia Generator, for the obvious advantage of accomplishing the creation of Flash or similar animations using a standard, widely available package for that purpose.

Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but media buyers brokering advertising space, etc., are well known, as taught, for example, by McCarthy (column 16, lines 15-

24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places. Kauffman does not expressly teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but "RedEye Recruitment" teaches using cookies to enable advertisers to identify users (two paragraphs beginning from, "Says Paul Cook, founder"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier information to be delivered from the syndication network to the media buyer as well as to the selector means, for the stated advantage of enabling advertisers to identify and target specific viewers, and personalize advertisements to individuals' needs.

Gever does not disclose a syndication network, but Kauffman teaches a syndication network for delivering to a computer operated by the user a multimedia advertising presentation (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have a syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

Gever discloses a hyperlink in the advertisement or other multimedia presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6). Gever does not expressly disclose that the hyperlink in the advertisement takes the user to an advertiser's website (although "LINK1 = 'WWW.BUYLATER.COM'" in Figure 4 is highly suggestive). However, it is well known for advertisements to contain hyperlinks to an advertiser's website, as taught, for example, by LeMole (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the hyperlink in the advertisement to be a hyperlink to an advertiser's website, for the obvious advantage of encouraging users to browse catalogs, etc., and make purchases at the advertiser's website.

Gever does not disclose assessing a fee to the user for delivery of the multimedia presentation, but it is well known to charge fees to users for viewing desirable content, fees being apportioned to one or more of the content owner, the owner of a delivery system, and/or the owner of a media buyer, as taught, for example, by "Sony Goes to the Net Via Visa" (especially the first paragraph). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to assess such a fee, for the obvious advantages of profiting from providing the services of providing and delivering content, and attracting advertisements by paying commissions to buyers.

Gever does not disclose assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, but it is well known to charge the sponsors of advertisements for running or displaying their ads, as taught, for example, by Krishan, Krishan further teaching payment to the owner of delivery means (column 1, lines 46-54). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, and apportioning payment, for the stated advantage of making money from displaying the selected advertisement.

Gever does not expressly disclose that the animation is an original presentation, but it could be taken as inherent that some animations are original presentations (not all animations could be copies of each other). Furthermore, the article, "Macromedia Flash Animation Now Native in RealSystem 5.0," discloses creating animations. But if, arguendo, this does not suffice, Borella teaches web pages including original content, including animation (column 4, lines 41-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the Flash animation to be an original presentation, for the obvious advantage of enabling the presenter to provide an animation according to his own desires and tastes, and to avoid having to pay royalties to someone else for use of a copied presentation.

Gever does not expressly disclose that there are multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, but it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for

multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)).

Furthermore, Markus teaches that many Web pages contain links to dozens of separate remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for there to be multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, for the obvious advantage of presenting multiple ads, at different points in a web site, and/or at different times during a multimedia presentation.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66, through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

It is noted that claim 35 uses "means for" language ("selector means"). Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**Claim 36**

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206) and Markus et al. (U.S. Patent 6,490,601). Gever discloses an Internet advertising method comprising: providing a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); providing a set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifying at least one demographic characteristic of a user(inherent from column 2, lines 36-52); selecting a relevant advertisement from the set of advertisements, the advertisement selection including a comparison of the user's at least one demographic characteristic with at least one demographic characteristic of each advertisement to select the relevant advertisement for the user (inherent from column 2, line 26, through column 3, line 5, and column 8, lines 3-10; providing an

appropriate animation sequence or other Web page component based on the geographic location of a visitor is held to imply means for making necessary comparisons, etc.); inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, creating an advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivering to the user a multimedia presentation including an advertisement, after identifying the user, including demographic information (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66,

through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

**Claim 37**

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S. Patent Application Publication 2002/0073084), Markus et al. (U.S. Patent 6,490,601), the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent 6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent 6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa," and optionally in view of Borella et al. (U.S. Patent 6,182,125). Claim 37 is closely parallel to claim 35, and rejected on essentially the same grounds.

***Response to Arguments***

Applicant's arguments filed January 20, 2006 have been fully considered but they are not persuasive. First of all, it is noted that Applicant traversed some of Examiner's

takings of official notice, to which Examiner has responded by making other prior art of record, and using these in statements of rejection. Traversals of official notice can be entirely proper, but the Manual of Patent Examination Procedure (2144.03(C)) states:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without reference to the examiner's assertion of official notice would be inadequate.

It may be questioned whether Applicant's traversals are proper, and in some cases it is not clear precisely what Applicant was traversing. Examiner is obliged to respond to even an entirely proper traversal of official notice only by documenting the fact(s) of which official notice was taken, not by finding a single reference which discloses all limitations of the claim(s) at issue. Whether there was proper motivation to combine the different references or known facts, making the claimed invention obvious

to one of ordinary skill in the relevant art at the time of the applicant's invention, is a different issue.

Applicant has traversed Examiner's taking of official notice in claim 3. In response, Examiner has relied upon LeMole et al. (U.S. Patent 6,009,410) to establish that it was known for advertisements (with animation, etc.) to contain hyperlinks to the advertisers' websites. Yacoby et al. (U.S. Patent 6,516,311) teaches this as well (column 9, lines 13-25).

Applicant has traversed Examiner's taking of official notice in claims 5-7. In response, Examiner has relied upon the article, "Macromedia Flash Animation Now Native in RealSystem 5.0" to establish that Flash is a well-known system for animations. In claim 6, Examiner further used Borella et al. (U.S. Patent 6,182,125) to establish, if necessary, that it is known for animations to be original.

Applicant has traversed Examiner's taking of official notice in claim 13. In response, Examiner has relied upon Simpson (U.S. Patent 6,453,300) to establish that Macromedia Generator was well known.

Applicant has traversed Examiner's taking of official notice in 14. In response, Examiner has relied upon Chen et al. (U.S. Patent 5,822,524) to establish that it was well known to store various programs and datafiles on a server.

Applicant has traversed Examiner's taking of official notice in claims 16 and 17. In response, Examiner has relied upon the Microsoft Press computer Dictionary to establish that the Internet was a well-known network, and on Jones ("Working on Site") to establish that the World Wide Web is part of the Internet.

Applicant has traversed Examiner's taking of official notice in claim 18 and its dependents, but in fact, no further taking of official notice was made in rejecting claim 18.

Applicant has traversed Examiner's taking of official notice in rejecting claim 22 and its dependent claim 23. In response, Examiner has relied upon McCarthy et al. (U.S. Patent 6,904,408) to establish that media buyers for advertising were well known.

Applicant has traversed Examiner's taking of official notice in claim 27 and its dependents. In response, Examiner has relied upon Krishan et al. (U.S. Patent 6,442,529) to establish that it was known to charge the sponsors of advertisements for running or displaying their ads.

Applicant has traversed Examiner's taking of official notice in claim 33. In response, Examiner has relied upon Sawyer (U.S. Patent 6,084,628) to establish that it was known to select advertisements randomly.

Applicant also traversed Examiner's taking of official notice in claim 34, but Examiner in fact rejected claim 34 (in the previous Office Action) based on three cited U.S. patent documents, without use of official notice.

Applicant has traversed Examiner's taking of official notice in claim 35 and parallel claim 37. In response, Examiner has relied upon the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent 6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent 6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan

et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa," and optionally Borella et al. (U.S. Patent 6,182,125) to establish various facts of which official notice was taken. Some of these facts are the same as some noted above in regard to other claims; additionally, "RedEye Recruitment" was used to establish that it was known to use cookies to enable advertisers to identify users; "Sony Goes to the Net via Visa" was used to establish that it was known to charge fees to users for viewing desirable content, fees being apportioned to one or more of the content owner, the owner of a delivery system, and/or the owner of a media buyer.

The common knowledge or well-known in the art statements in the previous office action which Applicant did not traverse are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Applicant argues, regarding claim 1 and the other independent claims, that Applicant's invention differs from Gever, even in combination with Singh, in that in Applicant's claims, advertisements are stored separately from a multimedia presentation, and added "on the fly." Examiner replies that this does indeed distinguish over Gever, but that Markus (made of record in response to Applicant's amendments) teaches an "ad server" model where pages are composite pages, requiring images, text, etc., to be pulled from several different remote internet resources, integrating banner ads (for example) into composite web pages. Markus teaches this, furthermore, as something already known at the time of his application, over which his invention represents an improvement. Examiner concludes, therefore, that this element of

Applicant's claims would have been obvious to one of ordinary skill in the art at the time of Applicant's invention.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yacoby et al. (U.S. Patent 6,516,311) disclose a method for linking on the Internet with an advertising feature. Gardner et al. (U.S. Patent 7,003,734) discloses a method and system for creating and displaying images. Beyda et al. (U.S. Patent Application Publication 2002/0082914) disclose a hybrid network based advertising system and method.

Giman ("National Web Ad Network for Alternative Weeklies") discloses a syndication service by which advertisers can purchase banner ads on many websites in a single transaction. Quinton ("U S West Dex to Sell Targeted Internet Ads; Directory Will Match Web Sites with Local Sellers") discloses a syndication service by which advertisers buy banner ads on multiple websites. The anonymous article, "GoTo.com's Online Marketplace Reaches More Than 10,000 Advertisers, 80,000 Network Affiliate Sites, an Estimated 10 Million Unique Users and a Top Relevance Ranking in NPD Survey," discloses a search syndication service with 80,000 affiliate sites.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Robert Pond, can be reached at 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

March 22, 2006